

## **Remarks**

### **1. Summary of the office action**

In the office action mailed February 8, 2011, (i) the Examiner rejected claims 1, 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0037068 (Thomas) in view of U.S. Patent No. 7,017,173 (Armstrong) and U.S. Patent No. 5,543,743 (Cooper), (ii) the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Armstrong, Cooper, and U.S. Patent No. 7,225,142 (Apte), and (iii) the Examiner rejected claims 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Armstrong, Cooper, and U.S. Patent No. 6,332,127 (Bandera).

### **2. Status of the claims**

Claims 1, 2, 5-11, 13-15, 17, 18, and 22-31 are pending. Of the pending claims, claims 1 and 29 are independent.

### **3. Response to the claim rejections**

The Examiner rejected independent claims 1 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Armstrong and Cooper. The Examiner stated that Thomas claims domestic priority to provisional application no. 60/193,894 filed on March 30, 2000. The Examiner further stated that a reference to "Thomas" shall include the claim of priority to the foregoing provisional application, and a reference to "Thomas Prov" (hereinafter, "Thomas Provisional") in a citation shall refer to that portion of the specification of the foregoing provisional application where the subject matter being discussed is disclosed.

Since the filing date of Thomas is after the priority date of this application, Applicants submit that the portions of Thomas that are not found within Thomas Provisional are not prior art

to this application. Accordingly, Applicants address the Examiner's rejections based on Thomas Provisional, Armstrong, and Cooper, rather than Thomas, Armstrong, and Cooper.

Pursuant to M.P.E.P. § 2145, subsection X.D.2., "It is improper to combine references where the references teach away from their combination." According to the Federal Circuit, "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." See, *In re Francis S. Gurley*, 27 F.3d. 551, 553 (Fed. Cir. 1994).

Applicants submit that, at the time of Applicants' invention, a person of ordinary skill, upon reading Thomas Provisional, would have been led in direction divergent from the path that was taken by the Applicants. For instance, Thomas Provisional states, "In conventional systems, pausing a real-time or recorded program causes the system to 'freeze' the current picture. For anyone viewing the media, the time the program is paused is *useless or frustrating*." See, Thomas Provisional, page 2, lines 3-6, emphasis added. Furthermore, Thomas Provisional states, "When a user pauses a real-time or recorded program, the media recording system presents pause-time content *instead of a paused picture of the last frame*." See, Thomas Provisional, page 2, lines 18-20.

Applicants submit that, at the time of Applicants' invention, the foregoing teachings of Thomas Provisional clearly would have led the skilled person away from Applicants' claimed features of "continuing to display the user selected program content on the display of the video

replay system, wherein the user selected program content displayed during the time delay is paused,” as recited in claim 1, and “continuing to display the video stream on the display of the video replay system, wherein the video stream displayed during the time delay is paused,” as recited in claim 29. Accordingly, Applicants submit that Thomas Provisional teaches away from their claimed invention.

Next, in rejecting the claims, the Examiner cited to Armstrong for disclosing (i) a method and apparatus for inserting advertisements and/or other information into an audio-visual presentation in response to a user’s pressing a pause or stop key, (ii) a delay following the user’s pressing the pause or stop button, during which time the subscriber equipment displays selected user program content as still imagery, and (iii) during the foregoing delay, while the user-selected content is showing, the user may select advertising for viewing and then view the same. *See*, e.g., office action, page 4, last paragraph, and page 5, first paragraph.

Even if it is assumed, for the sake of argument, that Armstrong discloses the foregoing functions, since Thomas Provisional discloses that the time the program is paused is *useless or frustrating* and that when a user pauses a real-time or recorded program, the media recording system presents pause-time content *instead of a paused picture of the last frame*, Applicants submit that, at the time of Applicants’ invention, the skilled person would not have modified Thomas Provisional to carry out the foregoing functions allegedly disclosed by Armstrong. Accordingly, Applicants submit that the Examiner erred by combining Thomas Provisional with Armstrong.

Next, in rejecting the claims, the Examiner stated that Cooper discloses providing a continuous analog or digital signal that includes a reference signal that identifies an event that triggers a timer, which timer counts down a period greater than zero seconds after which, *a video*

*output such as color burst is displayed.* See, office action, page 5, third paragraph. Afterwards, the Examiner stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method ... disclosed in Thomas with the use of a pause key ... disclosed in Armstrong, and use of a digital timer to set a delay period prior to *displaying video content* as disclosed in Cooper. See, office action, page 5 last paragraph and page 6, first paragraph.

Applicants respectfully submit that the Examiner's interpretation of Cooper is erroneous. Cooper provides for generating a delayed reference (e.g., a delayed reset pulse) in response to a received reference. See, e.g., Cooper, abstract, column 4, lines 8-10, and column 4, lines 29-30. Applicants submit that Cooper does not disclose or suggest displaying any of the reference signals.

Furthermore, with regard to color burst, Cooper discloses "The present invention will now be described by way of example with respect to its preferred embodiment as utilized with analog NTSC video signals which is made up of *color burst*, horizontal syncs, defining horizontal lines, and vertical syncs defining fields. As is well known in the art, in video like and many other reference signals a sync component defines a negative period determined by a negative transition followed by a positive transition, and a positive period determined by a positive transition followed by a negative transition. It will be appreciated that these periods may be maintained in the delayed reference signal such that equipment to which it is coupled will recognize the delayed reference the same as it would recognize the input signal. As is well known in the art, the NTSC video signal has a period of 4 fields which fields are defined by the relative relationship of horizontal sync, vertical sync and *color burst phase*." See, Cooper, column 2, lines 43-58.

Applicants submit that Cooper's disclosure regarding color burst does not amount to displaying a color burst signal. Accordingly, for at least the reasons discussed above with regard to Cooper, Applicants submit that the Examiner's interpretation of Cooper is erroneous.

Furthermore, since the Examiner's interpretation of Cooper is erroneous, Applicants submit that Cooper does not make up for Thomas and Armstrong's deficiency of not disclosing, upon entering the pause mode, the video replay system starting a timer and subsequently using the timer to determine whether *a time delay greater than zero seconds has elapsed*, and *after the video replay system determines that the time delay has elapsed*, displaying, on the display of the video replay system, the first ad instead of the user selected program content.

For at least the foregoing reasons, Applicants submit that independent claims 1 and 29 are not obvious over Thomas Provisional, Armstrong, and Cooper, nor are they obvious over Thomas, Armstrong, and Cooper. Furthermore, Applicants submit that dependent claims 2, 5-11, 13-15, 17, 18, and 22-28, 30, and 31 are allowable for at least the reason that each of those claims depends from one of claims 1 and 29.

#### 4. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. For the foregoing reasons, Applicant submits that claims 1-2, 5-11, 13-15, 17, 18, and 22-31 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the pending claims.

Respectfully submitted,

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